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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/262,870	03/04/1999	MICHAEL D. ELLIS	UV-48	1124
7590	05/20/2004		EXAMINER	
MICHAEL E SHANAHAN FISH & NEAVE 1251 AVENUE OF THE AMERICAS NEW YORK, NY 100201104			LONSBERRY, HUNTER B	
		ART UNIT	PAPER NUMBER	2611
DATE MAILED: 05/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/262,870	ELLIS, MICHAEL D.
	<b>Examiner</b>	<b>Art Unit</b>
	Hunter B. Lonsberry	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 February 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26,50-74,98-122 and 146-148 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-26,50-74,98-122 and 146-148 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>19</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Election/Restrictions***

Applicant's election without traverse of Group I (Claims 1-26, 50-74, 98-122 and 146-148) in Paper No. 18 is acknowledged.

### ***Response to Arguments***

The final office action of 11/21/03 was defective as claims 146-148 added by Amendment C were received prior to the mailing of Final Rejection dated 11/21/03. Amendment C had not been matched to the application and thus were not considered. The following is a new non-final office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 5-15, 17-26 50-52, 54-65, 67-72, 98-122, and 146-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over by U.S. Patent 5,850,218 to LaJoie in view of U.S. Patent 4,506,387 to Walter.

Regarding claim 1, 21, 25, and 98, LaJoie discloses an EPG system which runs on STB 6 with S-Video output 47 for displaying images (column 13, lines 5-21), the STB can display a partial program guide onscreen (508) at the same time as a TV program, the EPG displaying information on a VOD program listing (Figure 29, Box 566, Figure

25, 508, column 29, lines 5-58), a user may select a VOD event and after selection a media server streams that program solely to the user who selected it (column 1, lines 43-49, column 2, lines 1-7, column 7, line 4-column 8, line 10, column 16, lines 10-51, Figure 5). LaJoie inherently includes means for displaying VOD program listings as in Figure 5, LaJoie discloses a service table with a channel 15, with a VOD service type in column 103, and parameter table 129, and that the electronic program guide reads service, channel and descriptive information by referring to column 125 in table 103. LaJoie does not disclose displaying a VOD program immediately when a user selects a VOD listing, but does disclose transmitting it immediately afterwards. Walter discloses a VOD system which transmits a program faster than real time, a program may be transmitted in its entirety or may be partially transmitted thus allowing a user to view the program after the request and after the user presses the start button (column 7, lines 37-column 8, line 56). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to allow a user to view a program after selection as taught by Walter thereby allowing a user to watch a program whenever they wanted.

Regarding claims 2 and 99, LaJoie shows in Figure 25, an EPG that is overlaid over a TV program.

Regarding claims 3 and 100, LaJoie shows in Figure 25, a screenshot 492, in which a TV program has been reduced to show an unobscured view of the EPG.

Regarding claims 4 and 101, LaJoie shows in Figure 24, that a user may use the up/down keys 128 on a remote to select VOD programming (column 29, lines 33-36).

Regarding claims 6 and 102, LaJoie discloses in Figure 4, that a subscriber may press an "I" button to display the EPG in the main display.

Regarding claims 7 and 103, LaJoie discloses in Figure 6, that a user may press an "I" button to turn off the EPG display.

Regarding claim 8 and 104, LaJoie Discloses in Figure 26, that a user may press the select button 136 on a remote control to get detailed information on a VOD program.

Regarding claims 9 and 105, LaJoie discloses in Figure 18, that a user may press the "Guide" key to receive more detailed information on a program.

Regarding claims 10 and 106, LaJoie discloses in Figure 4, that a user may press the "I" key to receive detailed information on a program, in Figure 25, LaJoie discloses that a user who presses the B key may purchase a VOD event.

Regarding claims 11 and 107, LaJoie discloses in Figure 4, that a user may change channels by pressing a +/- key 102.

Regarding claims 12, 13, 108 and 109 LaJoie discloses a method of ordering VOD programs in advance via an electronic program guide (Figures 29-32, Figure 29: list of times 568, column 31, lines 33-49), the programs can be recorded to a VCR via a timer which is set by a user (Figure 12).

Regarding claim 14, LaJoie discloses in Figure 25, that a user may place an order for a VOD program via the program guide.

Regarding claim 15, 113 and 114, LaJoie Discloses in Figure 25, that a VOD program is identified by a PPV designation in the program guide, in screenshot 508, and that a favorites icon 166 may be used (Figure 8, column 19, lines 29-38).

LaJoie/Walters do not disclose indicating that a program is available on demand, but do disclose that programs may be delivered on demand. The examiner takes official notice that the use of an icon to indicate that a program is a VOD program is well known in the art, for example a channel icon VOD1. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the icons of LaJoie/Walters to include an icon to indicate a VOD program thus enabling a user to readily identify VOD programming.

Regarding claim 17 and 115, LaJoie discloses that VOD programs may be ordered and set on a timer for viewing in Figure 14.

Regarding claim 18, LaJoie discloses that parents may block channels for viewing by children via entry of a control code (column 13, lines 36-43, column 17, lines 15-22) and that a PIN code may be required to order a program (Figure 28).

Regarding claim 19 and 131, LaJoie discloses in Figure 29, that a user may order a VOD event via a program guide, select a start time, and automatically starting the program at the selected start time (column 31, lines 33-67).

Regarding claims 20 and 116, LaJoie reminds a user of the start time for a previously ordered VOD program (Figure 30, column 31, lines 50-67).

Regarding claims 22, 118, and 132, in Figures 30-32, LaJoie reminds the user of a start time for an ordered program and provides an option to watch the program at the selected start time.

Regarding claims 23, 24, 119, and 120, LaJoie discloses a system in Figures 30-32, which reminds a user of a start time and provides VOD event menu for selecting additional times to purchase programming.

Regarding claims 26 and 122, LaJoie discloses a system in Figures 30-32 which reminds a user of a start time and allows a user to cancel the event via a press of the c button (column 32, lines 23-44).

Regarding claims 50 and 146-148, LaJoie discloses an EPG system which runs on STB 6 with S-Video output 47 for displaying images (column 13, lines 5-21), the STB can display a partial program guide onscreen (508) at the same time as a TV program, the EPG displaying information on a VOD program listing (Figure 29, Box 566, Figure 25, 508, column 29, lines 5-58), a user may select a VOD event and after selection a media server streams that program solely to the user who selected it (column 1, lines 43-49, column 2, lines 1-7, column 7, line 4-column 8, line 10, column 16, lines 10-51, Figure 5). LaJoie inherently includes means for displaying VOD program listings as in Figure 5, LaJoie discloses a service table with a channel 15, with a VOD service type in column 103, and parameter table 129, and that the electronic program guide reads service, channel and descriptive information by referring to column 125 in table 103. LaJoie does not disclose displaying a VOD program immediately when a user selects a VOD listing, but does disclose transmitting it immediately afterwards. Walter discloses a VOD system which transmits a program faster than real time, a program may be transmitted in its entirety or may be partially transmitted thus allowing a user to view the program after the request and after the user presses the start button (column 7, lines

37-column 8, line 56). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to allow a user to view a program after selection as taught by Walter thereby allowing a user to watch a program whenever they wanted.

Regarding claim 50, LaJoie discloses an EPG system which runs on STB 6 with S-Video output 47 for displaying images (column 13, lines 5-21), the STB can display a partial program guide onscreen (508) at the same time as a TV program, the EPG displaying information on a VOD program listing (Figure 29, Box 566, Figure 25, 508, column 29, lines 5-58), a user may select a VOD event and after selection a media server streams that program solely to the user who selected it (column 1, lines 43-49, column 2, lines 1-7, column 7, line 4-column 8, line 10, column 16, lines 10-51, Figure 5). LaJoie inherently includes means for displaying VOD program listings as in Figure 5, LaJoie discloses a service table with a channel 15, with a VOD service type in column 103, and parameter table 129, and that the electronic program guide reads service, channel and descriptive information by referring to column 125 in table 103. LaJoie does not disclose displaying a VOD program immediately when a user selects a VOD listing, but does disclose transmitting it immediately afterwards. Walter discloses a VOD system which transmits a program faster than real time, a program may be transmitted in its entirety or may be partially transmitted thus allowing a user to view the program after the request and after the user presses the start button (column 7, lines 37-column 8, line 56). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to allow a user to view a program after selection as taught by Walter thereby allowing a user to watch a program whenever they wanted.

Regarding claim 51, LaJoie discloses in Figure 29, an EPG that displays both a TV program in a window and a listing of VOD programs in a box 566; LaJoie discloses in Figure 6, a TV program that is overlaid with a program guide display. The examiner takes official notice that overlaid program guides are used to navigate VOD programming. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the overlaid program guide LaJoie to display VOD information thereby allowing a user to browse VOD programming while watching a TV program.

Regarding claim 52, LaJoie discloses in Figure 29, an EPG that displays both a TV program in a reduced sized window and a listing of VOD programs in a box 566.

Regarding claims 54 and 55, LaJoie discloses in Figure 4, that the EPG may be opened and closed by pressing the "I" key.

Regarding claim 56, LaJoie discloses that a user my press the select button for more detailed information on a VOD program.

Regarding claims 57 and 58, LaJoie discloses that a user my press the select button for more detailed information on a VOD program, which takes up the main display, the user may press the B button to purchase the program.

Regarding claim 59, LaJoie discloses that pressing the +/- button on the keypad may change the channel.

Regarding claim 60, LaJoie discloses that the VOD program may be ordered via the EPG in Figure 26.

Regarding claim 61, LaJoie discloses in Figures 28-29, that a user may select a start time to view a VOD program with the left and right arrow key (Figure 29: list of times 568, column 31, lines 33-49).

Regarding claim 62, LaJoie discloses that parents may block channels for viewing by children via entry of a control code (column 13, lines 36-43, column 17, lines 15-22) and that a PIN code may be required to order a program (Figure 28).

Regarding claim 63 and 64, LaJoie discloses a method of ordering VOD programs in advance via an electronic program guide (Figures 29-32, Figure 29: list of times 568, column 31, lines 33-49), the programs can be recorded to a VCR via a timer which is set by a user (Figure 12).

Regarding claim 65, LaJoie Discloses in Figure 25, that a VOD program is identified by a PPV designation in the program guide, in screenshot 508.

Regarding claims 67-70, LaJoie discloses in Figures 28-29, that a user may select a start time to view a VOD program with the left and right arrow key (Figure 29: list of times 568, column 31, lines 33-49), a reminder is provided and the program starts automatically at the selected start time, and the subscriber may switch to the event by pressing the "A" button (column 32, lines 21-33).

Regarding claims 71, 72, LaJoie discloses in Figures 28-29, that a user may select a start time to view a VOD program with the left and right arrow key (Figure 29: list of times 568, column 31, lines 33-49), a reminder is provided and the program starts automatically at the selected start time. La Joie does not provide a user a prompt in the reminder system to select a new start time, but does offer an option to cancel a VOD

event (Figure 12). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to offer a new list of start times in the reminder system to allow a user to reschedule a VOD event in the case they are unable to watch the program at their original time.

Regarding claim 110, LaJoie/Walter disclose a VOD ordering system with a PIN code. LaJoie and Walter do not disclose the use of a parental control code. The examiner takes official notice that entering a parental control code is well known in the art, for example the use of a code to unlock a blocked television channel. Therefore it would have been obvious to one skilled in the art at the time of invention to modify LaJoie and Walter to include a parental control code thus preventing young children from viewing rated R movies.

Regarding claims 111 and 112, Walter discloses storing a VOD movie in local storage and allowing a user to view it at any desired time (column 7, lines 37-column 8, line 56).

Regarding claim 117, LaJoie reminds a user of the start time for a previously ordered VOD program (Figure 30, column 31, lines 50-67). LaJoie does not give a user the option to watch a program immediately. Walter provides a user a VOD program and allows a user to watch it immediately by pressing a start button column 7, lines 37-column 8, line 56).

Claims 5 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,850,218 to LaJoie in view of U.S. Patent 4,506,387 to Walter in further view of U.S. patent 6,571,390 to Dunn.

Regarding claims 5 and 53, LaJoie discloses in Figure 20, a theme option of navigating TV programming via a remote control (column 26, lines 48-60). LaJoie/Walter do not disclose if VOD programming is grouped by theme. Dunn discloses a VOD application which allows a user to browse programming by category lists (Figures 12-13, column 12, line 54-column 13, line 23). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to include PPV/VOD programming in the category listings as taught by Dunn thereby making it easier for a subscriber to navigate programming choices.

Claims 16 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,850,218 to LaJoie in view of U.S. Patent 4,506,387 to Walter in further view of U.S. Patent 6330,586to Yates.

Regarding claims 16 and 66, LaJoie Discloses in Figure 25, that a VOD program is identified by a PPV designation in the program guide, in screenshot 508. LaJoie does not disclose the use of an icon to indicate a VOD event, but does use a record icon 506 in figure 25 to indicate a program, which is to be recorded. Yates discloses the use of a VOD Icon to identify a VOD application (column 26, lines 61-67). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify

LaJoie/Walter to include an icon to identify VOD programming as taught by Yates in a browser allowing a subscriber to easily identify programs to watch.

Claims 73, 74, 78, and 86-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,850,218 to LaJoie in view of U.S. Patent 4,506,387 to Walter in further view of U.S. Patent 5,982,303 to Smith.

Regarding claim 78, LaJoie discloses that a user may select a start time to view a VOD program with the left and right arrow key (Figure 29: list of times 568, column 31, lines 33-49). LaJoie/Walter do not disclose using the numeric keys to select a start time. Smith discloses the use of a numeric universal remote to program start times for a VCR (column 7, lines 40-53, column 9, lines 15-36). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie/Walter to allow a user to select a start time via numeric keys to enable a subscriber to order a program with fewer button presses on the remote as taught by Smith, thereby saving time for the subscriber.

Regarding claims 73, 74 and 86-89, LaJoie discloses in Figures 28-29, that a user may select a start time to view a VOD program with the left and right arrow key (Figure 29: list of times 568, column 31, lines 33-49), a reminder is provided and the program starts automatically at the selected start time, and the subscriber may switch to the event by pressing the "A" button (column 32, lines 21-33). Walter discloses playing a VOD program once a user presses a start button. LaJoie does not allow the subscriber to change the start time indicated on the reminder window to a new start time. Smith

discloses the use of a numeric universal remote to program start times for a VCR (column 7, lines 40-53, column 9, lines 15-36). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to include a set top storage device which plays back a stored program at a viewer defined start time as taught by Walter and Smith in order to allow a user to view a VOD program at any time, including times in which the program is not available for download.

Claims 81 and 82, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,850,218 to LaJoie in view of U.S. Patent 4,506,387 to Walter in further view of the News.com article.

Regarding claims 81 and 82, LaJoie discloses in Figure 25, that a price is provided to a user for ordering a VOD event. LaJoie/Walter does not disclose pricing discounts for a subscriber who advance orders a VOD event. News.com discloses that a user may preorder the Windows98 software prior to release and receive a discounted price. Therefore, it would have been obvious to one skilled in the art at the time of invention to modify LaJoie to include a discount for pre-ordering in order to encourage more subscribers to order as taught by news.com.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HBL



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PRIMARY EXAMINER